Remarks:

Reconsideration of the application, as amended herein and in light of the remarks below, is respectfully requested. Claims 70-84 and 86-115 were pending as of the mailing of the Office Action to which this Amendment response[1]. Claim 85 had been cancelled by the previous amendment. Claim 101 is amended herein to correct a clerical error.

I.   Double Patenting.

The Office Action alleges that pending claims 72 and 102 of the instant application conflict with claim 103 of Application No. 10/918,967 ("the '967 application). The Office Action further alleges that pending claim 84 conflicts with claim 119 of Application No. 09/941,682 ("the '682 application").

The characterization of conflicting claims relates to statutory double patenting under 35 U.S.C. § 121. Double patenting refers generally to an investigation of whether an invention is claimed twice and is determined "by analysis of the claims as a whole." General Foods Corp. v. Studiengesellschaft Kohle GmBH, 972 F.2d 1272 (Fed Cir. 1992).

No double patenting exists here because instant claims 72 and 103 relate to computerized prescription systems whereas claim 103 of the '967 application relates to a method for creating a prescription from a computerized system. Additionally, pending claim 84 is distinct from claim 119 of the '682 application because they have different scope and various differing elements.

Furthermore, and as detailed below, since the method claims of the '682 and '967 applications can be practiced with one or more materially different system(s), they do not conflict with the instant claims and, therefore, the double patenting rejections are improper. See MPEP § 806.05, 806.05(h)

A.   **Claims 72 and 102 of the instant application are not in conflict with claim 103 of the '967 application.**

(i)   Claim 72

Dependent claim 72 of the instant application relates to a computerized prescription system and depends from dependent claim 71. Claim 71, in turn, depends from independent claim 70, as follows:

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[1] The Current Office Action states claims 70-115 are pending. Applicant respectfully points out that claim 85 was cancelled by the

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70. A computerized prescription system, comprising: at least one user computer, said user computer having a graphical user interface for displaying and providing access to:

 (1) a plurality of patient records, each patient record including information about a patient's prescription history; and

 (2) information about pharmaceuticals correlated with medical conditions for which the pharmaceuticals are suitable for treating, said information derived from at least two of said plurality of patient records.

Claims 71 and 72 further limit the computerized prescription system set forth in claim 70.

Claim 103 of the '967 application differs from claim 72 in that it is a method claim. The method recited within claim 103 of the '967 application may be practiced using a materially different product (system). Additionally, claim 103 does not contain the limitation relating to a "plurality of patient records," as required by claim 72 of the subject application. Applicant asserts that the aforementioned unique limitations and scope of claim 72

previous amendment dated July 19, 2006.

of the instant application create the required clear

line of demarcation to obviate the Double Patenting

rejection.

(ii) Claim 102

Independent claim 102 of the instant application also

relates to a computerized prescription system and

requires a plurality of patient records and further

requires "at least two" prescription histories.

In contrast, claim 103 of the '967 application is a

method claim; furthermore, claim 103 does not require at

least two prescription histories as set forth in claim

102 of the instant application. Thus, the method as

claimed in claim 103 of the '967 application can be

practiced with another materially different product.

Applicant asserts that the aforementioned unique

limitations and scope of claim 102 of the instant

application create the required clear line of

demarcation to obviate the Double Patenting rejection.

For at least the reasons set forth above, claims 72 and

102 of the instant application are not in conflict with

claim 103 of the '967 application. Since no conflict

exists between the distinct inventions set forth in

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these claims, applicants respectfully traverse the double patenting rejection.

B.   Claim 84 of the instant application is not in conflict with claim 119 of the '682 application.

Claim 84 of the subject application recites a computer implemented method of formatting an electronic prescription.

On the other hand, claim 119 of the '682 application relates to a method of using a system and provides for sorting records based on prescribed drugs approved by a drug benefits provider. The method of claim 119 of the '682 application can be practiced with another materially different product. For at least these reasons, applicant asserts a clear line of demarcation exists between claim 84 of the instant application and claim 119 of the '682 application. Since no conflict exists between the distinct inventions set forth in these claims, applicants respectfully traverse the double patenting rejection. Reconsideration and withdrawal of the double patenting rejection is requested.

II. REJECTIONS UNDER 35 U.S.C. 103(a)

Claims 70 - 77, 81 - 82, 84 - 86, 91 - 100, 102 - 107,

112 - 113 and 115 were rejected under 35 U.S.C. § 103(a)

as allegedly being obvious over U.S. Patent No.

5,390,238 to Kirk et al ("**KIRK**") in view of the "Lunar

Radiation Corp." ("**LUNAR**") article and further in view

of U.S. Patent No. 6,317,719 to Schrier ("**SCHRIER**"). As

the rejection (under § 103(a) set forth above)

encompasses all pending independent claims, Applicant

asserts that overcoming this rejection will enable all

pending dependent claims to similarly be allowable. In

response to the above-mentioned rejections, Applicant

respectfully traverses the above rejections by

demonstrating the following:

    1.   **SCHRIER** cannot be used to support an

        obviousness rejection because the subject

        invention was invented before the invention of

        SCHRIER. Because **SCHRIER** is used to support

        each of the rejections, the entire rejection

        set forth in item 4 of the Office Action must

        be withdrawn.

2. Assuming *arguendo* that **SCHRIER** is available as prior art, the combination of **KIRK** and **LUNAR** fails to render the subject invention obvious

3. **LUNAR** cannot be used to support an obviousness rejection due to a lack of enabling disclosure of the claims at issue.

A. SCHRIER CANNOT BE USED AS A REFERENCE TO SUPPORT AN OBVIOUSNESS REJECTION BECAUSE THE SUBJECT MATTER OF THE INSTANT APPLICATION WAS INVENTED BEFORE THE INVENTION OF SCHRIER

Applicant asserts that the cited **SCHRIER** reference is unavailable as prior art because the subject invention was invented before **SCHRIER**, which claims a priority to U.S. Patent Serial No. 08/167,286, filed December 13, 1993.

The Instant Application claims benefit to U.S. Patent Application Serial No. 08/330,745, filed Oct. 28, 1994. Applicant asserts conception and diligence extending before the December 13, 1993 priority date ("critical date") referred to above. In support thereof, Applicant submits herewith the following evidence:

1. Declaration under 37 C.F.R. § 1.131 of

    inventor Mayaud, with exhibits, to establish

    conception of the subject matter of the

    present claims prior to SCHRIER.

2. Analysis charts setting forth the location

    within the supporting material of each of the

    independent claims, claim element by claim

    element, with reference to page numbers

    (Exhibits are referenced by either POL or THB

    followed by a number).

3. A Declaration under 37 C.F.R. § 1.131 to

    support diligence of the inventor from a point

    in time prior to the critical date to the

    filing of the parent application in the

    present application.

Applicant has previously submitted congruous

declarations under 37 C.F.R. § 1.131 to show conception

and diligence towards reduction to practice from a date

at least before December 13, 1993 in copending U.S.

Patent Applications Serial Nos. 09/941,681, 09/941,682,

and 09/201,107 (now U.S. Patent No. 7,072,840). In

response thereto, the USPTO has accepted these

declarations each time as establishing conception and

diligence towards reduction to practice in each of the aforementioned '681 and '682 applications and '840 patent. The '681 and '682 applications, the '840 patent and the instant application are each continuation applications claiming benefit to the same priority date of U.S. Patent Application Serial No. 08/330,745, filed October 28, 1994.

The exhibits provided demonstrate the inventor possessed the subject invention prior to at least December 13, 1993 and that the inventor Mayaud was diligent from a point in time prior to the critical date to the filing date of the parent of instant application.

The attached charts, labeled as "Claim Addendum," list the elements of each of the independent claims in the subject application and page designations where support for each claim can be found in the Exhibits.

Also attached is a declaration from the Assignee describing diligence from the conception prior to the critical date until filing of the parent patent application. This is supported by an analysis of activity supported by notes in inventor Mayaud's daytime planner. The declaration of the Assignee further sets

forth that inventor Mayaud is not cooperative in executing his declaration.[2]

Applicant asserts that the declarations and evidentiary material submitted herein, which have already been accepted twice by the USPTO in related cases to antedate **SCHRIER**, are sufficient in this case to establish the subject invention was invented before the invention of **SCHRIER** because the underlying facts attested to in the declaration of the subject application are the same as those submitted within the declarations during prosecution of the '681 application and the '840 patent.

For at least all of the facts set forth above and in light of the accompanying documents, **SCHRIER** is not available to be used as prior art against the pending claims. Thus, since each of the rejections under § 103(a) requires combination with **SCHRIER**, the rejections under 35 U.S.C. § 103(a) cannot properly stand. Applicant respectfully requests reconsideration of the rejection of claims 70 - 77, 81 - 82, 84 - 86, 91 - 100, 102 - 107, 112 - 113 and 115 under 35 U.S.C. § 103(a) and withdrawal of this rejection.

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[2] In copending '681 application, the USPTO advised counsel that the Assignee should file a declaration for the non-cooperative inventor and sign the declaration on behalf of the inventor.

B. **ASSUMING *AGRUENDO* THAT SCHRIER IS AVAILABLE AS PRIOR ART, THE COMBINATION OF KIRK AND LUNAR FAILS TO TEACH OR SUGGEST THE SUBJECT MATTER OF THE PENDING CLAIMS**

> **(i)** **Pending claims 70, 84, 91, 96, 97, 99, 102 and 115 aggregate the data from multiple medical records and provide useful information derived from those records.**

The inventions of present invention can be used to collect and use data from multiple records. For example, paragraphs [0107] - [0108] of the instant application state:

> Of scientific note is that the system is privy to and operates at the confluence of three powerful emergent data streams: encyclopedic data on therapeutic agents intended to moderate particular conditions or patient problems; data on individual prescriber activity using skill and judgment to diagnose conditions or problems and make prescribing decisions selecting and applying therapeutic agents to diminish diagnosed conditions; and patient history data recording not only prescribing decisions but also the results of those decisions (see the description of FIG. 12, below). **Thus, the system captures not only prescribing activity but also the prescriber's intent, the problem or condition targeted by the prescriber in specifying a particular drug, and can track the success of that intent. The linkage of treatment with condition treated captures the reason why the doctor took the prescribing action that was taken.** This intent may, and can legally, be different from approved FDA therapeutic indications for a drug.
>
> **Of commercial note is that the foregoing data may be aggregated for multiple users,** for

example by the host computing facility, for market research purposes. Also, an individual user's prescribing patterns may be reviewed by the user or by others. For example, drug benefits companies, can review the user's prescribing patterns for formulary compliance and respond by encouraging better compliance, where appropriate. Release of such data to third parties can be controlled to safeguard the privacy of the prescriber, or other health care provider, by prescriber-determined data access protocols specifying who, or what organization, department or group, may access what data, when they may access it and what they can do with it. For example, one physician may permit academic use for research studies and prohibit commercial use while another may permit either.

[Emphasis added] The benefits of providing aggregated data to third parties is additionally set forth, for example, in paragraph [0176], which states:

Pharmaceutical and managed care companies can gain marketing benefits from use of the system to introduce new drugs or new uses of old drugs to physicians, in a relevant manner, at a moment of peak interest.

[Emphasis added] And, paragraphs [0183] and [0184], which states, in part:

The historical drug-prescribed and condition-treated records obtainable by using the invention can provide a basis for condition-based treatment guidelines developed by drug formularies. This novel data provides a new vehicle for outcome research for managed care, leading to new approaches to cost-effective prescription treatments.

Compilation of an extensive or **national database of** (patient-anonymous) **records providing a statistical historical listing of drugs prescribed versus associated conditions for which they were prescribed** would be in the

public interest and of considerable value, so
long as patient-confidentiality were maintained.

[Emphasis added] As such, Applicant's specification
supports the use of prescription information from
multiple records to derive information on drugs-
prescribed correlated with conditions-treated.

Additionally, as stated in paragraph [0108] of the
instant application, set forth above, the instant
application supports the review of a plurality of
records to determine prescribing practices of an
individual prescriber. This is supported elsewhere in
the instant application, for example, in paragraph
[0165] of the instant application, which states, in
part:

> **Review of a physician's prescribing record,**
> detailing the various drugs selected to treat
> the different conditions exhibited by the
> patients encountered in the physician's daily
> practice, **can reveal valuable information about
> the physician's prescribing practices** and the
> degree to which they follow formulary
> guidelines.

[Emphasis added] As such, the instant application
supports the aggregation of data from multiple records
to determine such things as: the drugs prescribed
correlated with the medical conditions for which the
drugs are prescribed; and the prescribing practices of

an individual prescriber. The use of such aggregated

data is claimed in several pending claims.

(ii) <u>**Pending claims 70, 96 and 102 require, among**</u>
<u>**other limitations, access to information about**</u>
<u>**pharmaceuticals correlated with medical**</u>
<u>**conditions for which the pharmaceuticals are**</u>
<u>**suitable for treating, derived from at least**</u>
<u>**two patient records.**</u>

Pending claim 70 recites, among other limitations:

at least one user computer, said user computer
having a graphical user interface for displaying
and providing access to:

(1) **a plurality of patient records**, each
patient record including information about
a patient's prescription history; and

(2) **information about pharmaceuticals**
correlated with medical conditions for
which the pharmaceuticals are suitable for
treating, <u>**said information derived from at**</u>
<u>**least two of said plurality of patient**</u>
<u>**records**</u>.

[Emphasis added] Similarly, pending claim 96 recites,

among other limitations:

b. a computer program stored on said memory
medium, said computer program containing
instructions for capturing prescription
information and providing access to:

(1) **a plurality of patient records**, each
patient record including information about
a patient's prescription history; and

(2) **information about pharmaceuticals**
correlated with medical conditions for
which the pharmaceuticals are suitable for
treating<u>**, said information derived from at**</u>

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least two of said plurality of patient records.

[Emphasis added] And, Applicant's previously presented claim 102 recites, among other limitations:

> at least one user computer, said user computer having a graphical user interface permitting capture of prescription information **and providing access to all of**:

>> (1) information about **a plurality of prescription histories**;

>> (2) **information about pharmaceuticals correlated with the medical conditions for which the pharmaceuticals are suitable for treating**, **said information about pharamaceuticals being derived from at least two of said plurality of prescription histories**; and

>> (3) information about the properties of pharmaceuticals;

[Emphasis added]

The **KIRK** and **LUNAR** references, taken alone or in combination, fail to teach the **pharmaceuticals correlated with medical conditions** for which the pharmaceuticals are suitable for treating, and the **said information derived from at least two of said plurality of patient histories**, as required by pending claims 70, 96 and 102. KIRK discloses a system whereby approval is obtained from a pharmacist and from a physician (col. 3, lines 35-39) Approval from the pharmacist and physician does not teach or suggest information about a

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plurality of patient histories and information about
pharmaceuticals correlated with patient conditions, as
claimed in the subject application. Further, as stated
on page 3 of the current Office Action, **KIRK** does not
teach or suggest information about pharmaceuticals
correlated with medical conditions for which the
pharmaceuticals are used for treating. The Office
Action further states on page 3, **LUNAR** by reciting the
words "patient's medical history" does not disclose
information about **pharmaceuticals correlated with
medical conditions** for which the pharmaceuticals are
suitable for treating. Likewise the limitation of
deriving information from at least two patient records
about pharmaceuticals correlated with medical conditions
for which the pharmaceuticals are used for treating as
claimed in the subject application is not disclosed by
LUNAR.

As such, Applicant's claims 70, 96 and 102 are believed
to be patentable over **KIRK** and **LUNAR**, taken alone or in
combination.

> (iii)   <u>Pending claim 84 requires, among other
> limitations, sorting the received
> prescription information from at least two
> patient records to create a list of
> pharmaceuticals correlated with the medical
> conditions for which the pharmaceuticals
> were prescribed.</u>

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Pending claim 84 recites, in part:

> **sorting** the received prescription information
> **from at least two patient records <u>to create a
> list of pharmaceuticals correlated with the
> medical conditions</u>** for which the pharmaceuticals
> **were prescribed;**

[Emphasis added] **KIRK** teaches a system for dispensing

medication and receiving approval from a pharmacist and

a physician. There is no mention of "sorting the

received prescription information from at least two

patient records to create a list of pharmaceuticals

correlated with the medical conditions for which the

pharmaceuticals were prescribed" as claimed in the

subject application. **LUNAR** teaches "treatment

programs" but does not elaborate or give any detail.

LUNAR does not have any mention of "sorting the received

prescription information from at least two patient

records to create a list of pharmaceuticals correlated

with the medical conditions for which the

pharmaceuticals were prescribed" as claimed in the

subject application. The **KIRK** and **LUNAR** references,

taken alone or in combination, fail to teach or suggest

among other limitations, sorting the received

prescription information from at least two patient

records to create a list of pharmaceuticals correlated

with the medical conditions for which the

pharmaceuticals were prescribed, as required by pending claim 84.

(iv) <u>Pending claims 91 and 115 requires, among other limitations, a sorting device for sorting the information from at least two of said plurality of medical histories to produce a report correlating at least one individual prescriber with at least one therapeutic agent prescribed by said at least one individual prescriber and with said at least one medical condition for which said at least one therapeutic agent was prescribed by said at least one individual prescriber.</u>

Pending claims 91 and 115 recite, in part:

> a sorting device **for sorting the information from at least two of said plurality of medical histories** to produce a report **correlating at least one individual prescriber with at least one therapeutic agent prescribed by said at least one individual prescriber and with said at least one medical condition** for which said at least one therapeutic agent was prescribed by said at least one individual prescriber;

> [Emphasis added]

KIRK is a health support system [that] provides support in part by dispensing medication in accordance with a predetermined schedule (col. 3, lines 3-5). **KIRK** has no teaching or suggestion for the sorting device of the claimed invention. **LUNAR** only recites the "patient medical history" and does not have any indication relating to the system having the sorting device of the claimed invention. The **KIRK** and **LUNAR** references, taken

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alone or in combination, fail to teach or suggest among

other limitations, **sorting the information from at least**

two medical histories to produce a report correlating at

least one individual prescriber with at least one

therapeutic agent prescribed by the individual

prescriber and at least one medical condition for which

the therapeutic agent was prescribed, as required by

Applicant's claims 91 and 115.

> **(v)** **Pending claim 97 requires, among other limitations, sorting the received prescription information from at least two records to create a list of pharmaceuticals correlated with the medical conditions for which the pharmaceuticals were prescribed.**

Pending amended claim 97 recites, among other

limitations:

> **sorting** the received prescription information **from at least two records** **to create a list of pharmaceuticals correlated with the medical conditions** for which the pharmaceuticals were prescribed.
>
> [Emphasis added]

Based on the arguments and distinctions stated

immediately above in sec II(B)(iv) the **KIRK** and **LUNAR**

references, taken alone or in combination, fails to

teach or suggest among other limitations, **sorting** the

received prescription information **from at least two**

records to create a list of pharmaceuticals correlated

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with the medical conditions for which the

pharmaceuticals were prescribed, as required by

Applicant's claim 97.

> **(vi) Applicant's claim 99 requires, among other limitations, sorting the received prescription information from at least two records to create a list of pharmaceuticals correlated with the medical conditions for which the pharmaceuticals were prescribed.**

Applicant's amended claim 99 recites, among other

limitations:

> c. said computer program containing instructions for **sorting the information from at least two of said plurality of medical histories to produce a report correlating** at least one individual prescriber **with at least one therapeutic agent prescribed by said at least one individual prescriber and with said at least one medical condition** for which said at least one therapeutic agent was prescribed by said at least one individual prescriber, and for outputting said report.

> [Emphasis added]

Based on the arguments and distinctions stated

immediately above in sec II.(B)(iv) the **KIRK** and **LUNAR**

references, taken alone or in combination, fails to

teach or suggest among other limitations, instructions

for **sorting the information from at least two of said**

plurality of medical histories to produce a report

correlating at least one individual prescriber with at

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least one therapeutic agent prescribed by said at least

one individual prescriber and with said at least one

medical condition for which said at least one

therapeutic agent was prescribed by said at least one

individual prescriber, as required by Applicant's claim

99.

> (vii)   **The cited art does not teach or suggest "drug
> formularly information" as recited within
> claims claims 100 and 101.**

Claims 100 and 101 recite, among other limitations:

> b) **drug formulary information identifying at
> least one of multiple drugs as a patient's drug
> benefit provider's drug formulary preferences** to
> ensure that the electronic prescription is
> filled with a benefit plan recommended drug;

> [Emphasis added]

Neither **KIRK**, nor **LUNAR** teach or suggest the use of

"drug formulary information" as claimed by Applicant in

claims 100 and 101. **KIRK** neither teaches nor suggests

drug formulary preferences.

The Office Action alleges, in part:

> Furthermore, as per claim 100, "Lunar Radiation
> Corp." teaches a means of providing drug
> formulary preferences (of a patient's drug
> provider) to ensure that the electronic
> prescription is filled with a benefit plan
> recommend drug ("Lunar Radiation Corp.": Main
> Paragraph, Sentences 2 and 4). The motivation

for making this modification to the combined
system of Kirk in view of "Lunar Radiation
Corp." and Kehr was the same as that was set
forth in the rejection of claim 70 above. (Note
"Lunar Radiation Corp." teaches that database
results are retrieved and displayed and this
information includes patient information as well
as therapy (drug) information. The examiner
takes the position that drug formulary
preferences is within the scope of therapy
information. **Furthermore, "Lunar Radiation
Corp." states that the above stated information
is provided to "ensure that the electronic
prescription is filled with a benefit plan
recommended drug"** and the examiner takes the
position that since the motivation of using the
system of "Lunar Radiation Corp." is to provide
users with more meaningful and efficient record
management the above stated reason for ensuring
that benefit plan recommended drugs are
prescribed is to ensure that the prescription
drug system functions more efficiently.

See Office Action, at 4-5. [Emphasis added] Applicant

respectfully disagrees that the **LUNAR** reference

discloses Applicant's claimed "drug formulary

information". Nowhere does LUNAR teach or suggest **"drug**

formulary information". In fact, the Office Action

states **"Lunar Radiation Corp." discloses that the above**

stated information is provided to "ensure that the

electronic prescription is filled with a benefit plan

recommended drug". However, nothing in **LUNAR** suggests

using **a benefit plan recommended drug**. Rather, the

citable prior art portion of **LUNAR**, as provided to

Applicant with the Office Action, states **in its**

entirety:

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Lunar Radiation Corp. has introduced patient database software as a standard feature of its IBM-based DP3 and SP2 bone densitometers.

The patient data base is dBASE III compatible and allows retrieval of patient information to meet your needs. **Scan results can be recalled chronologically to aid monitoring of therapy and to display disease process and patient progress. The database can also store information on a patient's medical history, fracture history, referring physician, treatment programs and changes, and insurance coverage**. Data entry fields allow the input of additional patient information for more efficient and meaningful record management.

[Emphasis added]

LUNAR'S single paragraph disclosure recites the words "patient's medical history, fracture history, referring physician, treatment programs and changes and insurance coverage." These broad terms have no detail regarding selection of drugs based on "drug formulary information." The specification of the subject application, in paragraph [0039] describes the selection based on formulary requirements as follows:

System suggestions for condition-related drug selection may be further refined into categories such as relative cost, generic or brand name and so on. Where many drugs are available for treating a patient's active condition, one particularly useful presentation is by multiple lines of therapeutic preference according to drug formulary guidelines. Thus, within the patient's particular formulary there may be suggested first, second and third lines of therapy. Different suggestions may be made for different patients according to the

preferences of the patient's particular drugs benefit management company.

The words "treatment programs" disclosed in **LUNAR** do not restrict treatment based on a patient's drug formulary's preferences as claimed in the present invention. As such, the disclosure of "treatment programs" in **LUNAR** would not teach or suggest Applicant's claimed "drug formulary information." Further, the insurance coverage of a patient relates to **by whom** the patient is insured, **and would not suggest to a** person of skill in the art "drug formulary information", as required by Applicant's claims 100 and 101.[3]

In the absence of **LUNAR** teaching or suggesting "drug formulary information" as claimed by Applicant, claims 100 and 101 are believed patentable over the combination of **KIRK** and **LUNAR**.

(viii)   **The cited art does not teach or suggest a chronologically current version of the patient's prescription history "not being**

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[3] From the statements made in the Office Action, it is possible that a **different LUNAR** reference was provided to Applicant with the Office Action than is being reviewed by the Examiner. If the instant rejection is maintained, Applicant respectfully requests clarification of the location where in the reference the Examiner that ""**Lunar Radiation Corp." states that the above stated information is provided to "ensure that the electronic prescription is filled with a benefit plan recommended drug"**, as stated on page 5 of the Office Action.

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permanently stored" as recited within
claim 98.

Pending claim 98 has been amended to recite, among other

limitations:

> b. a computer program stored on said memory
> medium, said computer program containing
> instructions **for interrogating databases**
> expected to contain information about a patient
> based on a patient's relationship with the
> provider of that database **and for assembling
> patient information into a chronologically
> current version of said patient's prescription
> history,** said chronologically current version of
> said patient's prescription history being
> displayed but not being permanently stored.

[Emphasis added]   Claim 98 is supported, for example,

paragraphs [0074] - [0079] and paragraphs [0124] -

[0126], which state:

> The invention also provides novel data-retrieval
> network systems to retrieve relevant patient
> data elements from multiple remote heterogenous
> primary source databases. Preferably, **every time**
> a host computer facility receives a call from a
> user device for a patient history or patient
> record, **relevant data elements, for that record,
> or a record component** (e.g. the most recent six-
> month or twelve-month portion), **are retrieved
> from remote source databases, dynamically
> assembled, or integrated, into a virtual patient
> record,** as described above, and delivered to the
> user device as an integral system data set.
> Alternatively, record assembly, which does not
> require undue hardware resources, can be
> performed on board the user device.
>
> **The record is viewed and may be printed out by
> the user,** with patient authorization, **but does
> not need to be permanently stored.**

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The host computer facility responsible for dynamic assembly of the virtual record logs the time, date and calling user to provide an audit trail of access to the patient's record, **but does not commit the record to permanent storage. After use, the virtual patient record disappears, although it can be reconstructed archivally.**

[Emphasis added]

Claim 98 recites a "virtual patient record" that is **chronologically current** and assembled **each** time it is requested, **and which is not permanently stored**, thus necessitating that the patient record is created anew each time it is requested.

This is neither taught nor suggested by **KIRK** or **LUNAR**. Rather, **KIRK** stores the patient's records permanently on the servers 38, including the financial data. See KIRK item 42 of Fig. 3; col. 3, lines 53 ("Operators 46, through monitoring terminal 44 and a communications link (preferably digital), can access data from local central servers 38, including financial data 42"). LUNAR discloses a patient database that allows retrieval of patient information. This is contrary to "assembling a chronologically current patient history that is not permanently stored" as claimed in the subject application.

Nothing in **KIRK** or **LUNAR** teaches or suggests <u>**assembling**</u>

a <u>**chronologically current** patient history</u> <u>**that is not**</u>

<u>**permanently stored**</u>. As such, Applicant's claim 98 is

believed to be patentable over **KIRK** and **LUNAR**, taken

alone, or in combination. Applicant respectfully

request reconsideration and withdrawal of this

rejection.

> **(ix) Claims 78-80, 83, 87-90, 108-110, and 113
> were improperly rejected under 35 U.S.C.
> § 103(a) as being unpatentable over Kirk
> in view of U.S. Patent No. 5,774,879
> (Custy).**

Applicant respectfully traverses this rejection based on

the arguments and distinctions stated immediately above

in sec II.(B)(ii) where the Office Action stated the

deficiencies in KIRK)relating to the **KIRK** reference and

the fact that combination of **KIRK** with **CUSTY** against

Applicant's dependent claims fails to cure the above

established deficiencies of **KIRK**. Applicant

respectfully requests reconsideration and withdrawal of

this rejection.

> **(x) Pending claim 101 was improperly rejected
> under 35 U.S.C. 103(a) as being unpatentable
> over KIRK in view of U.S. Patent No. 5,642,731
> to KEHR.**

Applicant respectfully traverses this rejection based on the arguments and distinctions stated immediately above in sec II.(B)(ii) where the Office Action stated the deficiencies in KIRK (relating to the **KIRK** reference where the Office Action stated the deficiencies in **KIRK**) KEHR teaches in col 6 line 65 - col. 7, line 7

> The monitor allows for interaction with physicians or pharmacists, who can upload information into the device, or download information from the device. The data that is stored in the monitor, enumerated above, can be downloaded into a personal computer or printer. The personal computer can be programmed to analyze the data that is downloaded, and then upload information in response to the information that was downloaded. The uploaded information could include warnings to the patient regarding dangerous behavior patterns of medication taking that have been recorded by the device, or other instructions to the patient based upon analysis of patient noncompliance, partial compliance, or potential drug interactions. For example, if the patient forgets to take the medicine Digoxin for heart disease, the device might display "TO AVOID HEART FAILURE YOU MUST TAKE DIGOXIN ON TIME!"

KEHR is a medication dispensing system with a warning regarding "dangerous behavior patterns of medication taking." **KEHR** does not have any teaching or suggestion regarding "a drug contraindication review automatically activatable from the prescription fulfillment system prior to fulfillment" as claimed in the subject application.

Additionally, the combination of **KIRK** and **KEHR** fails to

cure the above-established deficiencies of **KIRK** because

as seen in the above excerpt from Kehr cited in the

Office Action, **KEHR fails** to teach a drug

contraindication review automatically activatable from

the prescription fulfillment system prior to

fulfillment, contrary to the statements within the

Office Action.

Nothing in **KEHR** provides for a drug contraindication

review automatically activatable from the prescription

fulfillment system prior to fulfillment as set forth in

the present claim. **KEHR** solely teaches a warning that

may be issued after input of a medical record that is

independent of the prescription process. The

prescription can still be written and fulfilled prior to

any physician upload of information as described in

KEHR. Thus KEHR is deficient in its teaching. There is

no motivation to combine with KIRK or modify **KEHR** to

arrive at the prescription fulfillment software system

as currently claimed. Applicant respectfully requests

reconsideration and withdrawal of this rejection.

III. LUNAR CANNOT BE APPLIED TO SUPPORT AN OBVIOUSNESS REJECTION

Applicant further asserts that **LUNAR** is not available as a prior art reference. According to <u>Elan Pharms. v. Mayo Found. for Med. Educ. & Research</u> 346 F.3d 1051, 1054 (Fed. Cir. 2003), enablement requires that

> the prior art reference must teach one of ordinary skill in the art to make or carry out the claimed invention without undue experimentation.

<u>Elan</u> further sets forth:

> The disclosure in an assertedly anticipating reference must be adequate to enable possession of the desired subject matter. It is insufficient to name or describe the desired subject matter, if it cannot be produced without undue experimentation.

<u>Id.</u> at 1055. **LUNAR** is a news release from PR NEWSWIRE introducing a database incorporated into their bone densitometer. **LUNAR** recites: "The database (of the bone densitometer) can also store information on a patient's medical history, fracture history, referring physician, treatment programs and changes, and insurance coverage." Based on the standard set forth in <u>Elan</u>, the **LUNAR** reference cannot be used as a prior reference because **LUNAR** merely names certain features of the bone densitometer, but does not describe in any detail. Applicant asserts **LUNAR <u>does not</u>** have enabling

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disclosure within the four corners of the document to
demonstrate possession of the desired subject matter and
whatever subject matter is disclosed in **LUNAR**,
possession of the desired subject matter cannot be
produced without undue experimentation. Because the
LUNAR reference does not have the requisite adequate
disclosure, in cannot be used a reference in any of the
rejections set forth in the Action.

IV. Conclusion.

As stated herein, **SCHRIER** is not available as a prior
art reference to support the obviousness rejections
cited in the current Office Action. Additionally, the
pending claims are patentable over **KIRK and LUNAR**,
whether taken alone or in combination. Furthermore,
neither the **SCHRIER** nor the **KEHR** reference cited in the
Office Action in combination with **KIRK** and **LUNAR** against
the pending independent claims, nor the **CUSTY** reference,
cited against various dependent claims, cure the above
deficiencies of the **KIRK** and **LUNAR** references.

Accordingly, it is believed that none of the references,
whether taken alone or in any combination, teach or
suggest the features of claims 70, 84, 91, 96 - 102 and
115. Claims 70, 84, 91, 96 - 102 and 115 are,

therefore, believed to be patentable over the art. The

dependent claims are believed to be patentable as well

because they all are ultimately dependent on claims 70,

84, 91 or 102.

In view of the foregoing, reconsideration and allowance

of claims 70 – 84 and 86 – 115 are solicited.

In the event the Examiner should still find any of the

claims to be unpatentable, counsel would appreciate

receiving a telephone call so that, if possible,

patentable language can be worked out. In the

alternative, the entry of the amendment is requested, as

it is believed to place the application in better

condition for appeal, without requiring extension of the

field of search.

Please charge any fees that might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Robert M. Schwartz, P.A., No. 19-0734.

Respectfully submitted,

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